

## REMARKS

The Applicant appreciates the thorough review of the application by Examiner Nguyen. Reconsideration and allowance are requested.

Claims 1 - 11 remain pending in the application, including independent Claim 1.

**Claims 1-10 are patentable under 35 U.S.C. 103(a) over Nishio (USPN 5,713,785).**

Nishio discloses a grinding apparatus that exhausts the inside of a lid-shaped shield that encloses a rotating disk to suction up powder resulting from grinding of a surface. (Col. 1, lines 4-9 and 37-40) The improvement of Nishio is a replaceable skirt member that contacts the work surface to maintain a seal. This skirt member suffers abrasion but is easily removed and replaced, reducing maintenance expense (Col. 1, lines 40-62).

In contrast, the present invention is a grinding apparatus that can be held to a surface by suction power alone and operated remotely or with an extension. The elements of the present invention are designed to allow for this special mode of operation which has never before been achieved. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

Nishio fails to teach all the claim limitations of Claim 1. For example, Nishio does not teach one or more suction units, a number of spacer members (7) that are arranged adjustable and

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replaceable that establish an spacing adjustment of the grinding units (3) relatively to an underlying surface, or that the sealing members (8) interact with the suction units (21) for forming a vacuum that holds the grinding apparatus (1) against the said surface during operation.

Nishio teaches a grinding apparatus comprising a screen unit 2 and a pipe connection 7 for connecting with a suction hose 8. Nishio does not teach suction units. There is no specific explanation of the suction effect in a suction unit associated with the suction hose 8. Nishio does not teach a suction unit, which is explained in the Application to form vacuum in the screen units (For example, Page 4, line 23, Page 5 lines 12-13). A hose does not form vacuum.

The Examiner cites to element 5 of Nishio as teaching a spacer. Applicant cannot agree. Nishio teaches a resilient member 5 for the skirt member 22. The resilient member 5 exerts a constant downward pressure on the skirt, so that when the skirt member is pushed up by a convexity, the resilient member pushes it back down against the work surface 4. Resilient member 5 is not a spacer. It does not "enable an adjustment of the spacing of the grinding units in relation to the surface, entailing that it is possible to ... move the grinding apparatus across a surface without grinding the surface... which furthermore implies easy dragging of the screen unit across the surface... a great advantage if the grinding apparatus is suspended at great height on an element and is to be controlled by means of a handle." (Specification Page 5, line 4 to Page 6, line 5).

The resilient member 5 of Nishio has nothing to do with the spacing of a grinding element with a work surface. Rather, it keeps skirt member 22 pushed against the work surface at all times, which never affects the distance between the grinding element and the work surface at all. The purpose of the skirt member is only to keep a good seal. Claim 1 requires that the spacers (7)

establish a spacing adjustment of the grinding units (3) relative to an underlying surface. Nishio does not teach or suggest this feature.

Nishio also does not teach sealing members (8) that interact with suction units (21) for forming a vacuum that holds the grinding apparatus (1) against the surface during operation. The Examiner argues that skirt 22 and suction tube 8 form a vacuum that holds the grinding apparatus against the surface 4 during operation.

Applicant cannot agree. As explained above, Nishio does not teach a suction unit at all. Furthermore, from the description of the drawings it is clear that the apparatus according to Nishio is held onto the surface by hand and not by a suction force (see also the handle in Figure 2). The suction means is intended for sucking up the resolving powder from the surface. This is explained in the first paragraph of Nishio, column 1, lines 1-8. Moreover, the explanation of the suction hose, column 2, lines 46-48, does not disclose or describe that suction should be effected with such effect that a vacuum is formed in order to hold the grinding apparatus against the surface during operation. The present invention is designed to allow this novel operation- Nishio is not. Nishio relates only to the problem of sucking up the resolving powder from the surface that is being sanded.

The present invention makes it possible to hold an apparatus against a surface without any manual application of force on the apparatus. This is due to the fact that a number of screen units and a number of grinding units are used. Only one grinding unit and one screen unit is used in the Nishio patent. Accordingly, it is impossible for the apparatus to keep itself attached to a surface during operation.

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Nishio fails to teach a number of grinding units and drive units. The Examiner argues that "It would have been obvious to one having ordinary skill in the art at the time the invention was to include a number of grinding units and drive units, since it has been held that the mere duplication of the essential working parts of a device involved only routine skill in the art." The Examiner then cites St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

MPEP §2144.04 states: "If the facts in the prior art legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court." MPEP §2144.04 further states "If the Applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection."

St. Regis involved a patent to a gusseted type bag that differed from the prior art only in the use of an additional old element- multiple layers. 193 USPQ at 11. The Court held that the patent would be valid only if the fusion of the old elements created a synergistic combination and resulted in an effect greater than the sum of several effects taken separately. Because the claims involved the addition of multiple bags for strength, which did not create a synergistic effect with the other old elements, the Court held the patent to be invalid.

It is respectfully submitted that the facts of the St. Regis case are not sufficiently similar to those in the instant application to support Examiner's use of the precedent as a source of supporting rationale for a determination of obviousness. As discussed above, the prior art relied upon by the Examiner does not even disclose or suggest the features of Claim 1, which includes numerous elements that are not old. Additionally, Applicant has demonstrated that the multiple drives and grinding elements do have a synergistic effect with other elements, unlike the multiple

bags of St. Regis, by allowing the grinding apparatus to be held against a surface without any manual application of force on the apparatus. Accordingly, the Examiner's reliance on the precedent as the sole rationale to support the obviousness determination is improper under MPEP §2144.04.

As Nishio fails to disclose other limitations of Claim 1, and as there is no motivation or suggestion to modify the reference, Nishio fails to present a *prima facie* case of obviousness against Claim 1. It is clear that the Nishio patent does not relate to the problem of attaching and holding the apparatus against the surface.

For at least the reasons given above, Claim 1 is patentable over Nishio under 35 U.S.C. 103(a). Claims 2-10 depend from Claim 1 and add further patentable features, which the Examiner has not addressed. If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 25 USPQ2d 1443, 1447 (Fed. Cir. 1992) citing *In re Grabiak*, 226 USPQ 870, 873 (Fed. Cir. 1985). In fact, the office action does not provide any basis for the rejection of each of the features in every dependent claim and therefore applicant is unable to determine Examiner's basis for the rejection of each of the claims to adequately rebut the rejections. Therefore, as dictated by Oetiker "without more applicant is entitled to grant of the patent." For at least these reasons, the rejection of Claims 1 - 10 under 35 U.S.C. 103(a) over Nishio is improper and should be withdrawn.

Claims 11 is patentable under 35 U.S.C. 103(a) over Nishio (USPN 5,713,785) in view of Huchins (USPN 4,839,995).

Claim 11 depends from Claim 1 and add further patentable features. Huchins does not

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J C WRAY

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teach the features lacking in Nishio. For at least this reason, the rejection of Claim 11 under 35  
U.S.C. 103(a) over Nishio in view of Huchins is improper and should be withdrawn.

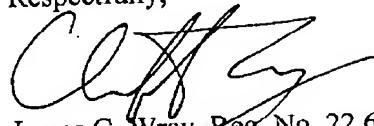
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## CONCLUSION

Reconsideration and allowance are respectfully requested.

Respectfully,



James C. Wray, Reg. No. 22,693  
Clifford D. Hyra, Reg. No. 60,086  
1493 Chain Bridge Road, Suite 300  
McLean, Virginia 22101  
Tel: (703) 442-4800  
Fax: (703) 448-7397

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